



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/257,879	03/02/99	MCGREDY	S 33947/VGG/R2

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HM12/1019

EXAMINER	
LOCKER, H	
ART UNIT	PAPER NUMBER
1661	8


DATE MAILED: 10/19/01

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

**A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET  
TO EXPIRE TWO MONTHS, DAYS FROM THE DATE OF THIS LETTER.**

*(see attached correspondence and request for information  
under 37 CFR 1.102)*

  
HOWARD J. LOCKER  
EXAMINER  
GROUP ART UNIT 1661

09/257879  
PTOL-50 (REV. 10/80)

**REQUIREMENT FOR INFORMATION UNDER**  
**37 CFR 1.105**

Applicant and the assignee (if applicable) of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'Macsupbow', was publicly available prior to the filing date of the instant application.

In response to this requirement, please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide copies of the published application, published proposed denomination, and published Breeder's Right grant. The Office does not maintain a collection of Breeder's Rights documents and they are not readily obtainable electronically. It is reasonable to expect that Applicant or assignee (if applicable) can readily obtain the requested documents and information.

The fee and certification requirement of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

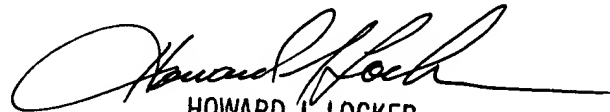
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Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or not readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

  
HOWARD J. LOCKER  
EXAMINER  
GROUP ART UNIT 1661

1. The request for a Continued Prosecution Application (CPA), filed on August 13, 2001 (filed under 37 CFR 1.53(d)), based on parent application serial number 09/257879 (filed March 02, 1999) has been accepted and entered. An action on the CPA follows.

**NOTE:** As noted in the previous Office correspondence, applicant's response, filed November 14, 2000, has effectively addressed the issues raised in the Office action mailed September 18, 2000.

### **35 U.S.C. 102**

2. The claimed rose cultivar 'Macsupbow' is described in Breeder's Right application number NZ PBR ROS573 which was filed on May 16, 1996 (proposed denomination filed concurrently) and published July 14, 1996 (denomination published concurrently), more than one year prior to the filing date of the instant application for United States Plant Patent. The published application and denomination constitute "printed publications" under 35 U.S.C. 102 because they were accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226; 210 USPQ 790, 794 (CCPA 1981). See also MPEP section 2128.

For example, UPOV publishes the application number, grant number, date of publication, species of plant, and variety denomination for PBR certificates, and copies of the grant and application are obtainable through the Plant Variety Rights Journal. Thus, information regarding the claimed cultivar, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications.").

While the publications cited above disclose the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the published application, combined with the knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Electronic and paper search within the Office has not revealed any evidence that the claimed plant was on sale anywhere in the world. However, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties (i.e. the public) free of charge. Since the inventor and the assignee (if applicable) of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information per the attached Requirement for Information Under 37 CFR 1.105.

A requirement for information under 37 CFR 1.105 is attached. This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months from the mailing date of this communication. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

3. Applicant is advised of the changes to 37 CFR 1.84 which took effect November 29, 2000 and apply to any applications (and to new drawings filed in previously existing applications) filed thereafter. In particular, 37 CFR 1.84(e) now states, in part:

**Photographs must be developed on paper meeting the sheet size requirements of paragraph (f) of this section and margin requirements of paragraph (g) of this section.**

The USPTO no longer accepts photographs mounted on Bristol board, paper or other material. Further information on the new rules is available on the USPTO web site at [www.uspto.gov](http://www.uspto.gov).

4. Applicant is advised of the new procedures for amending the specification and claim under 37 CFR 1.121. The new procedures are optional until February 28, 2001 and **mandatory** beginning March 01, 2001. Information on the new procedures is available on the internet at <http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html>.

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5. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campell, can be reached at 703-308-4205.

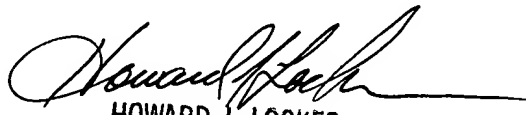
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703-308-0196.

### **TELECOPY/FACSIMILE TRANSMISSION**

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to this Group via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is 703-308-4242 or 703-305-3014.

Howard J. Locker/hjl

October 16, 2001

  
HOWARD J. LOCKER  
EXAMINER  
GROUP ART UNIT 1661